

Amendment and Response under 37 C.F.R. 1.116

Applicant: Daniel R. Marshall

Serial No.: 09/759,867

Filed: January 12, 2001

Docket No.: 10002307-1

Title: PORTABLE INFORMATION STORAGE MODULE FOR INFORMATION SHOPPING

REMARKS

This Amendment is responsive to the Final Office Action mailed January 15, 2004. In that Office Action, the Examiner rejected claims 30 and 34 under 35 U.S.C. §102(e) as being anticipated by Frenkiel et al., U.S. Patent Publication No. 2002/0198958 ("Frenkiel"). Claims 1-8 and 11-29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Frenkiel and Gibson et al., U.S. Patent No. 5,557,596 ("Gibson"). Claims 9, 10, 31-33, and 35-37 were rejected under 35 U.S.C. §103(a) as being unpatentable over Frenkiel and Gibson, as applied to claims 1-29, 30, and 34 above, and further in view of Gioscia et al., World Patent No. WO 00/30117 ("Gioscia").

With this Response, claims 34-37 have been amended to correct minor informalities and antecedent basis issues. Claims 1-37 remain pending in the application and are presented for reconsideration and allowance.

Claim Rejections under 35 U.S.C. §102

On page 2 of the Office Action, claims 30 and 34 were rejected under 35 U.S.C. §102(e) as being anticipated by Frenkiel. Frenkiel has a publication date of December 26, 2002 and a filing date of December 17, 2001. In addition, Frenkiel is based upon U.S. Provisional Application Serial Nos. 60/256,469 filed December 20, 2000; 60/259,159 filed January 3, 2001; and 60/278,273 filed March 23, 2001. For the purposes of the present Office Action, the earliest date that Frenkiel is available for use as prior art is the earliest provisional filing date of December 20, 2000.

Applicant is filing herewith a Declaration under 37 C.F.R. §1.131 to swear behind the earliest possible priority date of December 20, 2000 to remove Frenkiel as prior art. With removal of Frenkiel in light of the Declaration under 37 C.F.R. §1.131, the rejection of independent claims 30 and 34 under 35 U.S.C. §102(e) based upon Frenkiel is believed by the Applicant to no longer apply. Thus, Applicant respectfully requests reconsideration and withdrawal of the rejection, and allowance of independent claims 30 and 34.

Claim Rejections under 35 U.S.C. §103

On pages 3-11, claims 1-8 and 11-29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Frenkiel and Gibson. As previously discussed with respect to Frenkiel, Applicant is filing herewith a Declaration under 37 C.F.R. §1.131 to swear behind the earliest

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priority date of December 20, 2000 to remove Frenkiel as prior art. With removal of Frenkiel, the rejection of claims 1-9 and 19-21 under 35 U.S.C. §103(a) as being unpatentable over Frenkiel and Gibson is believed by the Applicant to no longer apply. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection, and allowance of claims 1-8 and 11-29.

On pages 11-13 of the Office Action, claims 9, 10, 31-33, and 35-37 were rejected under 35 U.S.C. §103(a) as being unpatentable over Frenkiel and Gibson, and further in view of Gioscia. As previously discussed, it is believed that Frenkiel has been properly removed as prior art for this application. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection, and allowance of claims 9, 10, 31-33, and 35-37.

CONCLUSION

In light of the above, Applicant believes independent claims 1, 15, 29, 30, and 34, and the claims depending therefrom, are in condition for allowance. Allowance of these claims is respectfully requested.

The Examiner is invited to contact the Applicant's representative at the below-listed telephone number to facilitate prosecution of this application.

Any inquiry regarding this Amendment and Response should be directed to either Michael R. Binzak at Telephone No. (612) 573-0427, Facsimile No. (612) 573-2005 or Philip S. Lyren at Telephone No. (281) 514-8236, Facsimile No. (281) 514-8332. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

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CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 12th day of March, 2004.

By Michael Binzak
Name: **Michael R. Binzak**